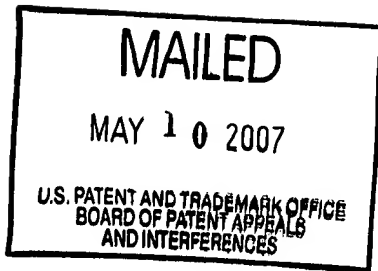


UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SUGIO MAKISHIMA  
and  
HIROSHI IGARASHI

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Application 09/922,869

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences on February 26, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an Appeal Brief was filed on August 7, 2006. The "Status of Claims"

appearing on pages 2 and 3 states that “[t]here are 13 claims pending in application” [page 2]. It also states:

B. Current Status of Claims

1. Claims canceled: none
2. Claims withdrawn from consideration but not canceled: 5, 6, 8, 9
3. Claims pending: 1-13
4. Claims allowed: none
5. Claims rejected: 1-3, 7, 10-13
6. Claims objected to: 4

Page 2 of the Examiner’s Answer mailed October 27, 2006 states that “[t]he statement of the status of claims contained in the brief is correct.”

The “Status of Amendments” appearing on page 3 of the Appeal Brief states:

Applicant filed an Amendment After Final Rejection on March 17, 2006. The examiner responded to the Amendment After Final Rejection in an Advisory Action mailed March 30, 2006. In the Advisory Action, the examiner indicated that Applicants’ proposed cancellation of claim 7 and amendment to rewrite objected-to claim 4 to include the limitations of its base claims would not be entered because these amendments raised new issues.

Accordingly, the claims enclosed herein as Appendix A do include claim 7 even though Applicant wishes to cancel this claim and do not incorporate the amendments to claim 4 that, according to the final Office action, would have made claim 4 allowable. However, the claims in Appendix A do

incorporate the amendments indicated in the paper filed by Applicant on July 12, 2005.

The Appeal Brief is deficient because the Appendix does not include a copy of claim 7. Correction is required.

In addition, the Final Rejection mailed January 20, 2006 states that “[c]laim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Tamura et al (US 6,771,896). However, neither the Appeal Brief filed August 7, 2006, nor the Examiner’s Answer mailed October 27, 2006, discuss the rejection of claim 7. Clarification is required.

Accordingly, it is


ORDERED that the application is returned to the examiner:

1) for notification to appellants to submit a corrected Appendix to the Appeal Brief filed August 7, 2006, which includes a copy of claim 7, or for the examiner to issue a revised Examiner’s Answer which contains a copy of claim 7;

2) for a determination regarding the status of claim 7; and

3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By:   
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PATRICK J. NOLAN  
Deputy Chief Appeals Administrator  
(571) 272-9797

PJN:psb

Birch Stewart Kolasch & Birch  
P.O. Box 747  
Falls Church, VA 22040-0747